

REMARKS

Claims 1-5 are now pending for the Examiner's consideration. Applicants request Examiner's reconsideration of the pending claims in light of the following remarks.

Rejection under 35 U.S.C. § 112 first Paragraph:

Claims 1-4 were rejected under 35 USC § 112 first paragraph for lack of written description for the reasons set forth on page 3-4 of the Office Action. Based on the relevant part of MPEP 2173.05(i), titled Negative Limitations, and the cases cited therein, Applicants believe amended claims 1-4 are fully supported by the disclosure.

The Applicable Rule and Law of Support for Negative Limitations:

MPEP 2173.05(i) third paragraph states, "a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support", and that "if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims".

In Ex parte Park (30 USPQ2d 1234, Board Patent Appeals and Interferences, 1993), the Board restated the principle that "adequate support under 35 U.S.C. § 112 first paragraph does not require literal support for the claimed invention" and that "it is sufficient if the original filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed".

The Board in Ex parte Park applied the above stated principle, noting that although there was no literal support for the negative limitation "in the absence of a catalyst", in the original filed disclosure, there were working examples in the original disclosure, wherein the claimed process was performed in the absence of a catalyst, and the Board found that that the original filed disclosure had conveyed to one of ordinary skill in the art that the appellant was in possession of the invention. The Board subsequently reversed the Examiner's final rejection of the claims for lack of support.

In In re Johnson (558 F.2d 1008, Fed.Cir. 1977), the proviso in claim 1 that "E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei" was added nine years after the original filing date with no literal support for this proviso in the original disclosure. The Court note that the original disclosure contained a broad and complete generic disclosure (the disclosure mentioned many choices for E and E'), coupled with extensive examples fully supportive of the limited genus with the proviso (twenty eight examples were within the genus with proviso) and found that the invention recited in claim 1, with the proviso, was fully supported by the original disclosure. I.d. 1017-1019.

Applicant's Arguments:

The Examiner's rejection is merely based the lack of literal basis in the specification for the amended proviso. However, the relevant parts of MPEO2173.05(i) and cases cited therein clearly show that lack of literal basis in the specification is not sufficient to find a lack of support for a negative limitation.

According to the Board decision in Ex parte Park, it is sufficient to satisfy the written description requirement, if the original filed disclosure conveys to one having ordinary skill in the art that the applicants of the patent application have possession of the claimed invention. Similar to the facts in In Re Johnson, and Ex parte Park, the current application provides not only a complete and detailed description of the definition of R^a, R^b, R¹ and R², including "halogen" as one of the many values that R¹ can be, the current application also provides many working examples, including those forty compounds in amended claim 4, that fall within the genus of the amended claim 1. Applicants therefore believe the genus of amended claim 1 of the current application is fully supported by the original disclosure. Claims 2-4 depend from claim 1 and contain all limitations therein. Therefore Applicants believe claims 1-4 are fully supported by the original disclosure.

Conclusion:

In light of the preceding remarks, Applicants request that the Examiner withdraw the rejection of claims 1-4 over 35 U.S.C. §112 first paragraph and rejoin claim 5. Applicants believe that all claims pending are now in condition for allowance and request a Notice of Allowance be issued timely. If the above remarks are not to the satisfaction of the Examiner, Applicants invite the Examiner to contact the undersigned.

If any fees other than those provided herein are due in connection with this response, please charge such fees to Deposit Account No. 500329.

Respectfully submitted,

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